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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY S. DWECK and REHA ELCI

Appeal 2009-001825
Application 10/016,673¹
Technology Center 2100

Decided: May 18, 2010

Before JAMES D. THOMAS, JAY P. LUCAS, and THU A. DANG,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ Application filed October 30, 2001. The real party in interest is Goldman, Sachs and Co.

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 to 26 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention relates to a method and apparatus for efficiently selecting documents for retrieval to a human or machine content reader based on comparing content selection tags to indicia related to the documents. In the words of Appellants:

A content provider can store information that will be made available to content readers. For example, a financial company might store hundreds of thousands of documents (*e.g.*, investment reports, stock charts, and market predictions) that will be made available to customers via a Web site.

....

According to one embodiment, information is received from a content reader. A set of content selection tags is established based on the received information, each content selection tag in the set being associated with a hierarchical tag domain. It is then arranged for the content reader to receive an indication of a document in accordance with the set of content selection tags.

According to still another embodiment, an indication of a first content selection tag set is received from a content reader via a graphical user interface, the first content selection tag set being adapted to facilitate identification of a first investment research document in accordance with a first document tag set. An indication of a second

content selection tag set is also received from the content reader, and the second content selection tag set is adapted to facilitate identification of a second investment research document in accordance with a second document tag set. It is then arranged for an indication of the first investment research document to be displayed via a first portion of a content reader display and for an indication of the second investment research document to be displayed via a second portion of the content reader display.

(Spec. 1, ll. 11 to 14 and Spec. 3, ll. 5 to 19).

Claim 1 and claim 20 are exemplary and are reproduced below:

1. A method of facilitating access to documents, comprising:
 - receiving information from a content reader;
 - establishing a set of content selection tags based on the received information, each content selection tag in the set being associated with a hierarchical tag domain;
 - arranging for the content reader to receive an indication of a document in accordance with the set of content selection tags; and
 - storing the set of content selection tags in association with the content reader.
20. The method of claim 19, wherein the first set of content selection tags is associated with a first portion of a reader display and the second set of content selection tags is associated with a second portion of the reader display.

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The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Beaulieu	US 5,502,637	Mar. 26, 1996
Husick	US 5,717,914	Feb. 10, 1998
Snow	US 6,098,066	Aug. 01, 2000
Anderson	US 6,510,434 B1	Jan. 21, 2003

REJECTIONS

The Examiner rejects the claims as follows:

- R1: Claims 1, 2, 4 to 12, 15 to 19, 22, 25, and 26 stand rejected under 35 U.S.C. § 103(a) for being obvious over Snow in view of Anderson.
- R2: Claims 3, 13, 20 and 21 stand rejected under 35 U.S.C. § 103(a) for being obvious over Snow in view of Anderson and Husick.
- R3: Claim 23 stands rejected under 35 U.S.C. § 103(a) for being obvious over Snow in view of Anderson and Beaulieu.
- R4: Claim 14 stands rejected under 35 U.S.C. § 103(a) for being obvious over Snow in view of Anderson and Beaulieu.

Appellants contend that the claimed subject matter is not rendered obvious by Snow alone, or in combination with Anderson, Husick and Beaulieu, for failure of the references to teach claimed limitations or to be properly combined. The Examiner contends that each of the claims is properly rejected.

The rejections will be reviewed in the order argued by Appellants. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to

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make in the Brief have not been considered and are deemed to be waived.
See 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue specifically turns on whether there is a legally sufficient justification for combining the disclosures of Snow and Anderson and whether Snow or Anderson teach a set of content selection tags as claimed.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a method of providing documents to document readers based on tags of the documents related to the technology sector to which it is related, or to other characteristics of the document (Spec. 9, ll. 17 to 27). These are compared to content selection tags, which indicate the subject matter for which the reader is seeking (Spec. 13, ll. 13 to 19). The content selection tags may be stored in association with the content reader (Spec. 14, l. 5).
2. Snow teaches the classification of documents into categories and sub-categories for searching in a node/tree structure (Col. 2, ll. 59 to 67). Likewise, Snow teaches content selection categories, chosen by a user, to specify the object of the search (Col. 8, ll. 49 to 67).

3. Anderson teaches category tags associated with documents being searched (Col. 2, l. 55). Search terms corresponding to domains and categories of indices are mapped to XML tags (Col. 3, ll. 12 and 13).

PRINCIPLES OF LAW

BURDEN AND REVIEW STANDARDS

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

“It is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 402 (2007).

References within the statutory terms of 35 U.S.C. § 103 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and,

(2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); *see also In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979) and *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

From our review of the administrative record, we find that the Examiner presents conclusions of unpatentability on pages 4 to 23 of the Examiner’s Answer. In opposition, Appellants present a number of arguments.

Arguments with respect to the rejection of claims 1, 2, 4 to 12, 15 to 19, 22, 25, and 26 under 35 U.S.C. § 103(a) [R1]

The Examiner has rejected the noted claims for being obvious over Snow and Anderson. Appellants argue first that the Examiner “has not provided a reasonable motivation to combine Snow and Anderson … as recited in the claims.” (Brief 5, top) (emphasis omitted). We find that each

of the references, Snow and Anderson, is from the same field of endeavor as the Appellants' invention, namely database searching with tagged documents, and that the Examiner has expressed a rationale for combining the teachings. In accordance with the principles of *In re Clay* (cited above) and *KSR* (cited above), we hold that the references may be properly combined.

Appellants then allege that neither Snow nor Anderson disclose "storing the set of content selection tags in association with the content reader" as claimed (Brief 6, bottom). The Examiner points to the storing of document tags, not to the storing of content selection tags, at Snow (col. 2, ll. 62 to 64; Ans. 24, top). However, the Examiner also points to Anderson (col. 2, l. 53 to col. 3, l. 7; Ans. 24, top). This latter Anderson teaching discusses receiving and necessarily holding sets of tags corresponding to the search request. We find this teaching sufficient to render obvious the claimed "storing the set of content selection tags in association with the content reader".

With regard to Appellants' arguments concerning claims 18, 19 and 20 (the latter rejected under [R2]), we find that Snow and Anderson provide the necessary teachings of portions of the display to render the claims obvious, for the reasons expressed by the Examiner which we adopt. (Ans. 24, bottom and 25, top).

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 26 under 35 U.S.C. § 103(a) as specified in rejections [R1] to [R4].

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DECISION

The Examiner's rejections [R1] to [R4] of claims 1 to 26 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb

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